

TWAF

TRANSMITTAL OF APPEAL BRIEF (Large Entity)	Docket No. TPP 30482A
---	---------------------------------

In Re Application Of: **Charles W. PROPST, Jr.**

Application No. 09/914,185	Filing Date August 23, 2001	Examiner C. Bruenjes	Customer No. 24257	Group Art Unit 1772	Confirmation No. 9479
--------------------------------------	---------------------------------------	--------------------------------	------------------------------	-------------------------------	---------------------------------

Invention: **CONDUCTIVE OR STATIC DISSIPATIVE COATING**

COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

The fee for filing this Appeal Brief is: **\$500.00**

- ☒ A check in the amount of the fee is enclosed.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 19-4375. I have enclosed a duplicate copy of this sheet.
- ☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Signature

Dated: **November 13, 2006**

Thomas P. Pavelko, Esquire
Registration No. 31,689
STEVENS, DAVIS, MILLER & MOSHER, L.L.P.
1615 L Street, N.W., Suite 850
Washington, D.C. 20036
Telephone: (202) 785-0100
Facsimile: (202) 785-0200

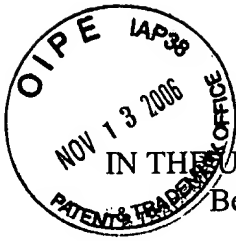
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

(Date)

Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

CC:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re the Application of

Charles W. PROPST, Jr.

Group Art Unit: 1772

Serial No.: 09/914,185

Examiner: C. Bruenjes

Filed: August 23, 2001

Confirmation No.: 9479

For: CONDUCTIVE OR STATIC DISSIPATIVE COATING

APPEAL BRIEF

Thomas P. Pavelko, Esquire
Registration No.: 31,689
STEVENS DAVIS, MILLER & MOSHER L.L.P.
1615 L Street, N.W., Suite 850
Washington, D.C. 20036
Telephone: (202) 785-0100
Facsimile: (202) 408-5200

11/14/2006 JADD01 00000031 09914185

01 FC:1402

500.00 OP

Date: November 13, 2006

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the inventor's interest, i.e., Spectra-Kote Corporation, with its principal offices in Gettysburg, Pennsylvania.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to Appellants, Appellants' legal representative or the assignee, which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 5 and 7 are subject matters of the appeal. All other claims have been cancelled.

IV. STATUS OF AMENDMENTS

No amendments after a final rejection have been filed. However, a Request for Reconsideration After Final Rejection was filed on August 14, 2006, and has been entered, as noted in the Advisory Action of August 30, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 5 is directed to a paper layer coated in direct contact with a film of a conductive polymeric composition; See, Specification, page 2, heading "Summary of the Invention," lines 2-11. The polymeric composition is a dried layer, which is formed from an intermediate composition comprising an aqueous methyl methacrylate polymer based solution, containing a quaternary ammonium compound in an amount of 1 - 10 weight % based on the weight of the polymeric composition; See, specification, line 12, to page 3, line 3; page 5, the first three lines following Example 3. The intermediate composition also comprises a polyethylene wax; See, specification, footnote *** on page 4, wherein said polymeric composition being deposited directly on and in contact with said paper is in an aqueous form and dried to form said film of polymeric composition to impart a static dissipative property and a

conductive property to said paper layer; See, specification, page 2, last paragraph to page 3, first line to page 5, fourth line to the bottom to page 6, first line.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Claim 5 is rejected under 35 U.S.C. §102(e) as being anticipated by Wang et al (U.S. Patent 6,048,679).

B. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Wang et al in view of Lu et al (U.S. Patent 5,130,177).

VII. ARGUMENTS

A. It is alleged by the Examiner that Wang et al anticipates the claimed invention under 35 U.S.C. §102(e).

In the Final Rejection, the Examiner stated “the limitation of ‘1-10 weight %’ for the amount of the quaternary ammonium compound is not seen as limiting, since none of the relative concentrations of the other components in the solution, such as methylmethacrylate or polyethylene wax are taught in the claim.”

In this, the Examiner is mistaken insofar as applicant has determined to claim the invention in the amount based upon “1-10 weight % based on the weight of the polymeric composition.” The polymeric composition has previously been defined as being “a dried layer formed from an intermediate composition.” Thus, it is irrelevant as to how much polyethylene wax and/or other materials are present since the quaternary ammonium compound is defined based on the weight of the polymeric composition.

On the contrary, Wang et al specifically state that in a photographic light sensitive material, there is an auxiliary layer such as an anti-static layer; See, generally, column 1, lines 30-47 and, specifically, lines 41-43. However, Wang et al is specifically silent on the amount of anti-static material being used and, thus, cannot possibly teach the “1 to 10 weight % based on the weight of the polymeric composition” as claimed. The Examiner either ignores the claim limitations or, alternatively, tries to shift the burden to appellant to show that Wang et al cannot possibly have the claimed weight of quaternary ammonium compound.

This is improper.

Even though the claimed invention is set forth in product by process format, the limitation in dispute is set forth as a positive limitation of "1 - 10 weight % based on the weight of the polymeric composition." This limitation is not dependent on the process steps of the product by process format. The Examiner's failure to find the recited limitation in the cited reference negates anticipation; See, MPEP § 2131 and cases cited therein. Nor can the Examiner's failure to find the recited limitation permissibly act to shift the burden to applicant to prove the negative teaching in the cited reference under any theory of inherency. Inherency means inevitability, not probability. See, *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d, 1949, 1950-51 (Fed. Cir. 1999). Thus, for the foregoing reasons, Wang et al cannot possibly act as an anticipatory reference of claim 5 and reversal of this rejection by the Board is warranted.

B. The secondary reference Lu et al does not teach or correct the foregoing deficiencies of Wang et al.

Although the specific claimed limitation requires 1 - 10 weight % based on the weight of the polymeric composition, Lu et al may employ a quaternary ammonium compound alone and not in combination with any polymeric material at all. As disclosed at column 4, line 39 *et seq.* of Lu et al, "the coating can consist entirely of the di-quaternary ammonium compound" Although patentees continue at column 5, line 11 *et seq.* that some types of binders may be used, there is no teaching of "methacrylate polymer based solution," as recited in independent claim 5 and incorporated by statute (35 U.S.C. §112, 4th paragraph) into dependent claim 7. For the foregoing reasons, appellant respectfully submits that the proposed combination of Lu et al with Wang et al is based entirely on hindsight reconstruction of the invention, without any motivation that would have impelled one of ordinary skill in the art to do what the inventor has done and that the proposed combination of references would, therefore, not have been obvious to one of ordinary skill in the art at the time the invention was made since even with the proposed combination of references, the deficiencies of Wang et al have not been overcome.

Appellant notes the Board of Appeals' decision in Ex Parte Levengood, 28 USPQ 2d, 1300, 1302 (BPAI 1993) wherein it was stated:

“Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that ‘would lead’ that individual to combine the relevant teachings of the references (citations omitted). Accordingly, the Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant’s invention without also providing evidence and the motivating force which would impel one skilled in the art to do what the patent applicant has done.”

In the instant case, it is only appellant’s disclosure that provides the 1-10 weight % of the quaternary compound and no proposed combination of Wang et al and Lu et al would have motivated one skilled in the art to do what the appellant has done. Accordingly, reversal of the rejection is respectfully requested.

VIII. CONCLUSION

The Examiner has not cited an anticipatory reference for the claimed invention of independent claim 5 and cannot shift the burden of the deficiencies of the reference to applicant to prove that the reference cannot possibly teach what applicants are claiming. In effect, the Examiner is arguing that the amount of 1 - 10 weight % is inherent in Wang et al, but there is absolutely no basis on which to make this assertion. The secondary reference, Lu et al, clearly teaches that an anti-static compound can be in an amount of 100 weight %, or less, depending on the presence of a binder. However, such does not make it inherent that the quaternary ammonium compound of appellant’s invention be in an amount of 1 - 10 weight % based on the weight of a polymeric composition comprising methyl methacrylate polymer base would have been “inherent” in the teachings of Wang et al. Accordingly, Wang et al fails to establish an anticipation of the claimed invention under 35 U.S.C. §102(e).

Furthermore, the Examiner’s reliance on the secondary reference, Lu et al, in rejecting claim 7 under 35 U.S.C. §103(a) also fails to establish a *prima facie* case of obviousness since the Examiner has not cited any motivation to provide the 1-10 weight % of quaternary ammonium compound as recited in dependent claim 7 (incorporated by statute, 35 U.S.C. §112, 4th paragraph, from independent claim 5 from which it depends).

Accordingly, neither rejection should be affirmed and reversal of both rejections is respectfully requested.

APPENDICES

The following Appendices are attached to and made part of this brief:

Appendix A	Claims Appendix under 37 CFR § 41.37(c)(1)(viii)
Appendix B	Additional Evidence under 37 CFR § 41.37(c)(1)(ix)
Appendix C	Copies of Decisions under 37 CFR § 41.37(c)(1)(x)

Respectfully submitted,



Thomas P. Pavelko
Registration No. 31,689

TPP/mat
Attorney Docket No.: TPP 30482A

STEVENS DAVIS, MILLER & MOSHER L.L.P.
1615 L Street, N.W., Suite 850
Washington, D.C. 20036
Telephone: (202) 785-0100
Facsimile: (202) 408-5200

Date: November 13, 2006

APPENDIX A

CLAIMS ON APPEAL

1-4. (Cancelled)

5. A paper layer coated in direct contact with a film of a conductive polymeric composition, said polymeric composition being a dried layer formed from an intermediate composition comprising an aqueous methyl methacrylate polymer base solution containing a quaternary ammonium compound in an amount of 1 to 10 wt% based on the weight of the polymeric composition and a polyethylene wax, said polymeric composition being deposited directly on and in contact with said paper in an aqueous form and dried to form said film of polymeric composition to impart a static dissipative property and a conductive property to said paper layer.

6. (Cancelled)

7. The paper layer of claim 5, wherein said intermediate composition further comprising an aqueous dispersion of zinc oxide particles.

8-22. (Cancelled)

APPENDIX B: Evidence Appendix under 37 CFR § 41.37(c)(1)(ix)

N/A

APPENDIX C: Related Proceedings Appendix under 37 CFR § 41.37(c)(1)(x)

N/A